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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,483	02/10/2004	Robert Worsham	12013/49301	8935
23838	7590	11/13/2006		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER TADESSE, YEWEBDAR T	
			ART UNIT 1734	PAPER NUMBER

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,483	WORSHAM ET AL.	
	Examiner	Art Unit	
	Yewebdar T. Tadesse	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
 - 4a) Of the above claim(s) 8-17 is/are withdrawn from consideration.
- 5) Claim(s) 3,4,18 and 19 is/are allowed.
- 6) Claim(s) 1,2 and 5-7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ransburg (US 2,658,472).

As to claim 1, Ransburg discloses (see Fig 1) an apparatus for electrostatic spray application of a coating material to a target comprising: a target holder (conveyor 11 with spindle 12) which holds a target at a first electrical potential; a coating discharge nozzle body (head 16) formed from an electrically conductive material (see column 3, lines 7-13), the nozzle having a nozzle orifice (29) for discharging the coating material; and means (high-voltage source 17) for applying to the nozzle body a second electrical potential to electrostatically discharge the coating material from the orifice toward the target, wherein the coating material capable of comprising a therapeutic agent.

With respect to claim 2, Ransburg discloses (see column 3, lines 33-38) a coating material reservoir (source); and a coating material conduit, wherein a first end of the conduit is in communication with the coating material in the coating material reservoir (28), a second end of the conduit (27) is in communication with the nozzle (29 or head 16), and the coating material flows from the reservoir through the conduit and out of the orifice when the second electrical potential is applied to the nozzle body.

As to claims 5-6, in Ransburg the target is capable of being a medical device including a stent and the coating material is capable of containing a therapeutic agent.

3. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ransburg (US 2,658,009).

As to claim 1, Ransburg discloses (see Fig 4) an apparatus for electrostatic spray application of a coating material to a target comprising: a target holder (conveyor 24) which holds a target at a first electrical potential; a coating discharge nozzle body formed from an electrically conductive material (see column 3, lines 3-6), the nozzle (12) having a nozzle orifice (discharge edge 16) for discharging the coating material; and means (high voltage 21) for applying to the nozzle body a second electrical potential to electrostatically discharge the coating material from the orifice toward the target, wherein the coating material capable of comprising a therapeutic agent.

With respect to claim 2, Ransburg discloses (see column 3, lines 21-27) a coating material reservoir (source); and a coating material conduit, wherein a first end of the conduit (20) is in communication with the coating material in the coating material reservoir, a second end of the conduit (15) is in communication with the nozzle, and the coating material flows from the reservoir through the conduit and out of the orifice when the second electrical potential is applied to the nozzle body.

As to claims 5-6, in Ransburg the target is capable of being a medical device including a stent and the coating material is capable of containing a therapeutic agent.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ransburg '472 or '009 as applied to claim 2 and further in view of Wollard (US 5,181,661). Ransburg '472 discloses a source of coating material feeding the tube 27 by positively produced pressure (see column 3, lines 33-38), but a pressurized fluid source in communication with a fluid passageway as claimed and the fluid passageway capable of creating a high velocity annulus surrounding the nozzle orifice are not taught in '472 or '009. Wollard discloses (see Fig 1) an electrostatic apparatus having a fluid passageway (5) positioned adjacent to a coating material conduit (3), wherein the first

end of the passageway in communication with the pressurized fluid source (see column 3, lines 12-14), a second end of the passageway is in fluid communication with the nozzle orifice (4), the pressurized fluid flows from the pressurized fluid source through the fluid passageway and out the nozzle orifice; wherein the fluid passageway is adapted to create a high velocity fluid annulus surrounding the nozzle orifice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a nozzle assembly or tubing, creating a high velocity fluid annulus surrounding the nozzle orifice, having a pressurized fluid source in communication with a fluid passage as claimed in Ransburg '472 and '009 to jet the coating material in a desired shape onto the substrate (see column 1, lines 37-40, the desired shape of the atomized coating particles in the form as flat as a cone).

Allowable Subject Matter

7. Claims 3-4 and 18-19 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: Fichaux (US 3,712,833) discloses a spark discharge generator (3) for descaling oxidized sheet metal before treating the sheet material in the electrochemical device (5). Fichaux does not teach the use of a spark discharge generator in the electrostatic spray application apparatus. Prior art of record does not disclose or suggest an apparatus for electrostatic spray coating, comprising, among others, a spark discharge generator

electrically connected to the target holder to remove an oxide layer from the target where the target contacts the target holder.

Response to Arguments

9. As to claims 1-2 and 5-6, Both Ransburg's devices are capable of spraying a therapeutic agent as described in the rejections above. The limitation directed to the type of coating material is a part of an intended use recitation and/or process steps. As such, the examiner maintains the art rejections over Ransburgs' references. Furthermore, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus shows all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) Furthermore, "**expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.**" *Ex parte Thibault*, 164 USPQ 666,667 (Bd. App. 1969). Thus, the "**inclusion of material or article worked upon does not impart patentability to the claims.**" *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 (USPQ 458, 459 (CCPA 1963))). In this case, the type of coating material does not impart patentability to the claimed apparatus.

Applicants' arguments with respect to claims 3-4 have been fully considered and are persuasive.

Art Unit: 1734

Applicants' arguments with respect to claim 7 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T. Tadesse whose telephone number is (571) 272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lemb 6/7
YTT